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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,490	02/06/2004	Jayendra H. Bheda	2003/03	6636

7590 10/23/2006

Invista North America, S.a r.l.  
Intellectual Property Records Center  
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Wilmington, DE 19808

EXAMINER
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TOSCANO, ALICIA

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 10/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/773,490

Applicant(s)

BHEDA ET AL.

Examiner

Alicia M. Toscano

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11, 13-25 and 27-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-25, 27-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1, 2, 8, 10, 15, 22 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Pfaendner (US Patent 563681).

This rejection is as set forth in the action dated 6/27/06..

Examiners remarks: Applicant argues Pfaendner does not disclose substituted anhydrides. Examiner points Applicant to monomers of Column 5, of which monomers Va-Ve can be substituted by those groups described in Column 5 Line 60-62.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
2. Claims 1-3, 5-9, 13-17, 19-23 and 27-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang (US Patent 6342578 B1) in view of Moeller (US Patent 6630050 B1).

This rejection is as set forth in the action dated 6/27/06.

Examiner adds rejection of Claims 13, 29 and 30 as the cyclic anhydrides of Moeller, by applicants own admission (see table 1 of specification), include anhydrides which have melting point of less than 100C and 25C.

Examiners remarks: The rejection over Huang in view of Moeller established a proper prima facie case. In re Hedges does not relate to the current argument. See In re Ruff (118 USPQ 340 (CCPA 1958), in order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art.

Examiner has established that the reaction between –OH terminus and a cyclic anhydride is recognized in the prior art. Further, a prima facie case of obviousness may be made when chemical compounds have very close structural similarities and similar utilities. "An obviousness rejection based on similarity in chemical structure and function entails the motivation of one skilled in the art to make a claimed compound, in the expectation that compounds similar in structure will have similar properties" In re

Payne (203 USPQ 245, 254 (CCPA 1979)). Examiner adds that Applicant is substituting methyl groups on the cyclic anhydride, the addition of a methyl group would not significantly change the properties of the resulting product.

3. Claims 11 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang and Moeller in view of Yamamoto. (JP Patent No. 06100767A)

This rejection is as set forth in the action dated 6/27/06.

Examiners remarks: The rejection over Huang and Moeller in view of Yamamoto established a proper prima facie case. See *In re Ruff* (118 USPQ 340 (CCPA 1958), in order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art. Examiner has established that PET and PEN are recognized as equivalent polyesters in the prior art.

4. Claims 4,13, 18 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang in view of Savariar-Hauck (US 5695905).

Huang includes elements of the invention as discussed above. Huang does not disclose the use of substituted cyclic glutaric anhydrides. Savariar-Hauck discloses compositions utilizing oxazoline modified acid polymers. Savariar-Hauck discloses the addition of carboxyl groups by reaction OH-group polymers with cyclic acid anhydrides (Column 4 Lines 62-66). Said anhydrides can be glutaric anhydrides or substituted glutaric anhydrides such as 3-methyl glutaric acid anhydride (Column 5 Lines 8-10).

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Thus, Savariar-Hauck teaches substituted and unsubstituted glutaric anhydrides to be functional equivalents. It would have been obvious to one of ordinary skill in the art at the time of the invention to replace the glutaric anhydride of Huang with the substituted glutaric anhydride, taught by Savariar-Hauck, since they are recognized as functional equivalents in the art.

***Response to Amendment***

***Response to Arguments***

5. Applicant's arguments, see Remarks, filed 9/27/06, with respect to the rejection(s) of claim(s) 1, 2, 4-6, 13, 15, 16, 18-20, and 29-30 under Malholtra have been fully considered and are persuasive. Malholtra teaches a coating with a polyester binder and a cyclic anhydride, however the coating is never cured. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Savariar-Hauck (US 5695905).


6. The rejection to Claims 1-3, 5, 6, 14-17, 19, 20 and 27-30 over Moeller (US Patent 6630050 B1) and Claims 12 and 26 over Moeller in view of Saunders are removed due to Applicants amendment/cancellation of claims in regards to use of a polyamide.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia M. Toscano whose telephone number is 571-272-2451. The examiner can normally be reached on Monday to Friday 8:30 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AMT

  
RANDY GULAKOWSKI  
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